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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,531	03/06/2001	Mary J. Hornberger	10002552-1	4150

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

KIM, PAUL L

ART UNIT	PAPER NUMBER
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2857

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,531

Applicant(s)

HORNBERGER ET AL.

Examiner

Paul L Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by Mallory et al.

Tuttle et al. teaches a system for remote testing of computers comprising: a network accessible site for providing input for a product under test by a network (fig. 1), a processing system for receiving inputs and presenting the input to the product under test (fig. 1, part 124), and a switch function that allows disconnection to the processing system (col. 13, lines 46-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 7-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable by Tuttle et al. in view of Mallory et al. and Silva et al.

With regard to amended claims 1, 3, 10, 13, and 14, Tuttle et al. teaches a system for remote testing of computers comprising: a network accessible site for

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providing an input for a product under test by a network (fig. 1), a processing system for receiving inputs and presenting the input to the product under test as if the input came from an input device connected directly to the product under test (fig. 1, part 124), and a controller that initiates test commands to the product under test (fig. 1, part 122).

Tuttle et al. teaches the test controller introducing software commands to the product under test, but does not teach the system introducing hardware commands not covered in software control to the product under test. Mallory et al. teaches an apparatus for testing computer systems that initiates hardware commands to a product under test by a test controller (fig. 1 and abstract). Because Tuttle et al. and Mallory et al. are both within the art of computer product testing, it would have been obvious to one having ordinary skill in the art, at the time the invention, to modify Tuttle et al., so that hardware commands instead of software commands are introduced to the product under test, as taught by Mallory et al., in order to be able to determine whether the product is operable and to be able to test a product that has no software installed.

Tuttle et al. teaches the computer testing apparatus being network accessible, but does not teach a *plurality* of users connected to the network. Silva et al. teaches a distributed testing system in which plurality of client testing machines communicate test result information to a host computer on a network (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention, to modify Tuttle et al., to have a plurality of users connected to the network, as taught by Silva et al., so as to test an entire network of computers on one testing system.

With regard to claim 2, Tuttle et al. teaches a software process running on the product under test (fig. 1, part 130 and col. 1, lines 15-19).

With regard to claim 5, Tuttle et al. teaches the input being in the form of a script (col. 7, lines 19-30).

With regard to claim 7, Tuttle et al. teaches a signal processor that intercepts display information from the product under test (col. 3, lines 41-45).

With regard to claims 8, 9, and 17, Tuttle et al. teaches a device configuration obtained from a user being used to configure or select a product under test (col. 6, lines 60+).

With regard to claims 11 and 15, Tuttle et al. teaches the processing system being separate from the product(s) under test (fig. 1, parts 124 & 108).

With regard to claim 12, Tuttle et al. teaches a switch function that allows disconnection to the processing system (col. 13, lines 46-60).

5. Claims 4, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Barar.

With regard to claims 4, 18, 19, and 20, Tuttle et al. teaches a system and method for remote testing of computers comprising: a network accessible site for providing input for a product under test by a network (fig. 1), forwarding the input for the product under test to a processing system and presenting the input to the product under test (fig. 1, part 124), and obtaining display information from the product under test (col. 3, lines 41-56).

Tuttle et al. teaches the test controller acquiring visual display signals from the product under test, but does not teach using a camera to obtain display information from the product. Berar teaches a semiconductor testing apparatus that uses a camera to acquire images of a product under test and transfers this data to a network accessible site (col. 1, line 63 to col. 2, line 14). Because Tuttle et al. and Berar are both within the art of product testing over a network, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Tuttle et al. so that a camera is used to obtain display information of a product, as taught by Berar, in order to inform users or customers the current situation of the products under test cost effectively.

6. Claims 6, 16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuttle et al. in view of Cromer et al.

With regard to claims 6, 16, and 21, Tuttle et al. teaches a database for storing information but does not teach a database that stores images of hard disk configuration. Cromer et al. teaches that a main computer storing hard drive configuration images for client systems are well known in the art (col. 7, lines 24+). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to modify Tuttle et al. so that hard drive configurations are stored on a main computer, as taught by Cromer et al., so as to be able to test different software setups for a variety of computers.

Response to Arguments

7. Applicant's arguments filed November 4, 2003 have been fully considered but they are not persuasive.

In response to the arguments on pages 2-5, and specifically to claims 1 and 13, applicant's attention is directed to column 2, lines 22-49 of the Mallory et al reference. Mallory et al clearly teaches a device that presents inputs to a product under test directly and presents commands not covered in software control.

With regard to arguments on pages 5-7 that the prior art of record (Berar) does not teach a camera capturing display information of the product under test, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

With regard to arguments on page 8 that Tuttle et al does not teach a switch function to disconnect the network from the processing system, it is inherent that a network has a switching device that separates the functioning of a network from a processing system.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Kim whose telephone number is 703-305-7468.

The examiner can normally be reached on Monday-Thursday 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 703-308-1677. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

PK
January 8, 2004


MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800